

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 22 1997

GROUP 2000

#23 Recov.
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12-23-97

Applicant: ALLEMAN
Serial No: 08/798/115
Date Filed: 2/12/97
Title: INTERACTIVE TELEPHONE SYSTEM
FOR MAKING LOW COST LONG
DISTANCE TELEPHONE CALLS

Examiner: MATAR

Group Art Unit: 2601

SUPPLEMENTAL
COMMUNICATION

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

On December 10, 1997, undersigned counsel and the inventor, Dr. Alleman, spoke by telephone to Examiner Matar to discuss two incidents in 1990 and 1991 in which Dr. Alleman had dealt with companies in the telephone communication business regarding his invention. Dr. Alleman stated that the invention was not obvious to one of ordinary skill in the art at that time because those involved in the two incidents were persons of ordinary skill and none conceived the invention claimed in this application.

Counsel proposed to place in the record the sworn description of the incidents as evidence of non-obviousness under Rule 132. Examiner Matar agreed to allow the declaration to be filed, but he expressed the view that the testimony regarding the two incidents was outweighed by the statements made in the International Callback Book.

It was pointed out that the International Callback Book was not prior art because it was dated in 1995, when the effective filing date of the application is 1992. Examiner Matar said that he could rely on the 1995 book because of the two cases attached to Paper 19.

The Examiner relies upon two cases to reject the claims of the present application under 35 U.S.C. § 103 (Paper 19). The first, *Ex parte Erlich*, 22 USPQ2d 1463 (BPAI 1992), relied upon its decision in *Ex parte Erlich*, 3 USPQ2d 1011 (BPAI 1986) which held that rejections under 103 were proper "based upon some of the references and the same reasoning now relied by the examiner" (page 4 of attachment to paper 19). The first *Erlich* case held that "one of ordinary skill in the art would have found the claimed hybridomas and monoclonal antibodies obvious from a consideration of the prior art." It did not rely upon literature that was **not** prior art, but rather it relied upon a consideration of "the prior art." Specifically, the Board in the cited case said that in the prior appeal it held that one of ordinary skill, "aware of the antigenicity and therapeutic value of human fibroblast interferon, would have found it obvious to use the classical method of Kohler and Milstein" (*id.*).

In the present case, there is no evidence that those in the art knew about international callback before Dr. Alleman invented it. Nor is there any evidence that DID was ever a "classical" technique for callback. The only evidence in this record is that DID allows a called party to know who is calling before pickup of the handset.

The *Erlich* case cited by the examiner relies upon "a large body of research work" by "numerous researchers" in the evidence of record (page 5 of attachment to

paper 19). While the Chemical Abstracts paper (Sevier) relied upon by the examiner as a survey of the prior art, and "itself is not prior art," it "cites a large number of references bearing publication dates" that show they are prior art.

In the present case, there is no survey containing "a large number of references" that are prior art. At page 19 of the latest Office action (paper 16), the Examiner quotes the International Callback Book, admitted to be a 1995 publication, for the statements that some entities "in 1991 and 1992" automated the process, using DID. **No prior art reference is cited** to support the statement, unlike the *Erlich* case. Moreover, the range "1991 and 1992" in the book is a broad one including *after* the effective filing date of the present application in 1992. The *Erlich* case certainly does not stand for the proposition that a 1995 book, that does not even purport to review the prior art, cannot be used to reject claims in an application filed in 1992. It is a violation of the statute to reject claims under Section 103 where there is no finding that the invention as a whole was obvious in view of the prior art. The International Callback Book is not prior art, and the Examiner cannot make a 1992 silk purse out of a 1995 sow's ear.

The *Erlich* case cites two cases in support of the proposition that a 103 rejection can be grounded on a reference that "establishes the level of skill in this art at and around the time of the present invention." The first is *Thomas & Betts Corp. v. Litton Systems, Inc.*, 220 USPQ 1 (Fed. Cir. 1983), which stated that Marketing and Engineering Criteria set by applicant's assignee was unpublished," and therefore were "not technically prior art," could be relied upon by the trial court in support of testimony of the expert of applicant that the criteria directed the inventor to go from 050 spacing

to 054 spacing which was "within the knowledge of one of ordinary skill in the art" (220 USPQ at 7). The testimony thus showed that "*the subject matter as a whole* would have been obvious" (*id*, emphasis present), because the engineering department directed the inventor to mate with standard "D" connectors, a routinist's task.

In the present case, there is absolutely no testimony and no "internal criteria" directing Dr. Alleman to use DID instead of the dedicated box he had previously developed. He made his invention on his own, without any direction from others, and there is no evidence to the contrary.

The other case relied upon in the cited *Erlich* case is *In re Farrenkopf*, 219 USPQ 1 (Fed. Cir. 1983). In that case, there was no doubt that the Rutner reference, which disclosed inhibitors to diminish the peptidase activity (219 USPQ at 3). It was held to be obvious to use the inhibitor disclosed in other art as the inhibitor in the Rutner method, a garden variety 35 U.S.C. § 103 rejection. This case provides no support whatever for the use of literature that is not prior art in order to reject claims under 103.

The *Erlich* case also contains an alternative ground for rejecting the claims based upon references that "are clearly prior art to the present claims" (page 5). Thus, the case does not stand for the proposition that one can reject claims based on literature that is not prior art, like the International Callback Book of 1995. The Examiner in the telephone call of December 10 made no reference to any prior art at all, only to the International Callback Book, which is admittedly not prior art (Paper 19).

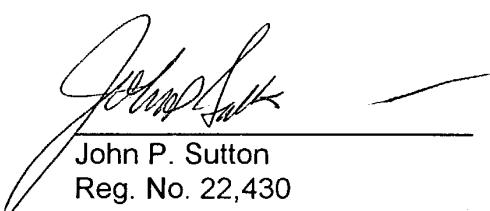
The case of *Gould v. Quigg*, 3 USPQ2d 1302 (Fed. Cir. 1987), also attached to Paper 19, has nothing to do with a rejection based upon 35 U.S.C. § 103. Rather it deals with the issue of whether an expert witness in a district court proceeding could properly rely upon an article published after the filing date of a patent application to show that the disclosure of the application was enabling under 35 U.S.C. § 112. There is no enablement issue here, so the case is not relevant. More importantly, the case holds that "It was not legal error for the district court to accept the testimony of an expert who had considered a later publication in the formulation of his opinion as to whether the disclosure was enabling as of the filing date" (page 6). Here, the experts Alleman and Casner have sworn that the invention taken as a whole was **not** obvious to a person of ordinary skill in the art at the time the invention was made, and there is no contrary evidence. The PTO does not have access to experts for testimony, and cannot rebut the testimony of record here regarding obviousness. All the Examiner can rely on is prior art. But he cannot rely on 1995 books that do not even purport to cite any prior art. The International Callback Book is merely anecdotal evidence that is undated. It is clear error to rely on a 1995 reference to reject claims in a 1992 application. At the interview with the Examiners Zele and Matar on November 4, 1997, it was agreed that the International Callback Book was not prior art.

The attached Declaration of Alleman is evidence that the invention, considered as a whole, was not obvious to one skilled in the art at the time the invention was made. It is submitted that all claims are allowable over the cited prior art.

Favorable action is solicited.

Respectfully submitted,

Date: Dec 19 1997


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Alleman)	Examiner:	Matar
)		
Serial No.:	08/798,115)	Group Art Unit:	2742
)		
Filed:	02/12/97)	DECLARATION OF ALLEMAN	
)	UNDER 37 C.F.R. § 1.132	
Title:	Interactive Telephone System for Optimizing Service Economy)		
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GROUP 2600

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

James H. Alleman, under penalty of perjury, declares:

1. I am the inventor of the above identified patent application. I make this declaration of my own personal knowledge.
2. On or about 14 November 1990 I met with James Anderson, then President of Call Interactive and Tom Thompson, then Vice President of Operations of Call Interactive and staff members of Call Interactive in Omaha Nebraska. Call Interactive was a joint venture of American Express and AT&T, and the engineering staff included employees of AT&T. Call Interactive had heard about the capabilities of my invention and I made a demonstration of call back in the conference room of Call Interactive, but without revealing my invention. The staff, including AT&T engineers, did not understand the technology and did not grasp the invention. None of the officers and staff persons made any hint that the invention was obvious to those persons of ordinary skill in the art. I later dealt with Call Interactive to commercialize my invention and no employee of Call Interactive gave any indication of obviousness of my invention at any time.

3. On or about 10 January 1991 I met with Don Routerbush, President, and staff members of One Call Long Distance, a division of Opticom as well with Joe Penze, President of Opticom, in Carmel, Indiana. The staff members were well aware of the state of the art in long distance telephone equipment and service, but none of them came up with my invention and none of them understood my invention before meeting with me. The invention was not obvious to any of these people in the telephone business.

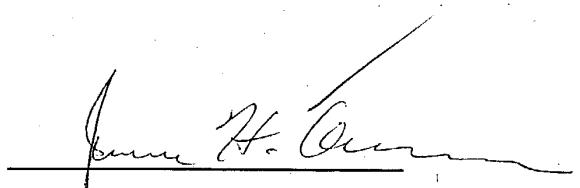
4. On or about 14 January 1991 I met with Edwin Blankenau, President of TeleNational, and his chief engineer. TeleNational was practicing call back with human operators at the time of my visit. TeleNational was extremely interested in automating the process. I later learned that it had hired a consultant, Gail Curtwright, to develop an automated call back process, but he was unsuccessful. I did not reveal the invention to TeleNational since the officers had not signed a non-disclosure statement. No one at TeleNational showed any comprehension of my invention.

5. On or about 8 January 1992, I met with Daniel Mer of ITT World Com in New York, New York, because he had been advised of the capabilities of my invention, but he did not comprehend my invention. It was not obvious to persons skilled in networks and systems in the telephone art.

6. I declare that all statements made on my own knowledge herein are true, and all statements made on information and belief are believed to be true, and I have been warned that willful false statements and the like are punishable by fine or

imprisonment or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon.

Dated: 19 December 1997



James H. Alleman